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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/813,604

03/31/2004

Thomas Palmieri

2006P26237 US

4357

28524

7590

08/11/2008

SIEMENS CORPORATION  
INTELLECTUAL PROPERTY DEPARTMENT  
170 WOOD AVENUE SOUTH  
ISELIN, NJ 08830

EXAMINER

WRIGHT, PATRICIA KATHRYN

ART UNIT

PAPER NUMBER

1797

MAIL DATE

DELIVERY MODE

08/11/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

**Advisory Action  
Before the Filing of an Appeal Brief**

**Application No.**

10/813,604

**Applicant(s)**

PALMIERI ET AL.

**Examiner**

P. KATHRYN WRIGHT

**Art Unit**

1797

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 8/4/2008 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires \_\_\_\_\_ months from the mailing date of the final rejection.  
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.  
Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**NOTICE OF APPEAL**

2. ☐ The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

**AMENDMENTS**

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because  
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);  
(b) ☐ They raise the issue of new matter (see NOTE below);  
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).  
5. ☒ Applicant's reply has overcome the following rejection(s): rejection of claim 32 under USC 112, first paragraph.  
6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.  
The status of the claim(s) is (or will be) as follows:  
Claim(s) allowed: \_\_\_\_\_.  
Claim(s) objected to: \_\_\_\_\_.  
Claim(s) rejected: 27-38.  
Claim(s) withdrawn from consideration: 39-47.

**AFFIDAVIT OR OTHER EVIDENCE**

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).  
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).  
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

**REQUEST FOR RECONSIDERATION/OTHER**

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:  
See Continuation Sheet.  
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s) \_\_\_\_\_.  
13. ☒ Other: See Continuation Sheet.

/Jill Warden/  
Supervisory Patent Examiner, Art Unit 1797

Continuation of 11, does NOT place the application in condition for allowance because: of arguments of record.

Further, regarding the restriction requirement, the Examiner asserts that claim 39 does not set forth all the same components as claim 27. As pointed out in item 4 of the Final action (6/4/2008), claim 39 includes a transfer shuttle positioned to slide in a direction perpendicular to a portion of the transporter device which not required by claim 27. Similarly, the restriction from Groups I and II do provide a reasonable example as to how these Group can be used to practice another materially different process, i.e., these apparatus do not require the step of optimizing the path for each sample, as discussed in item 3 of the Final. Since applicant received an action on the merits for the originally presented invention, i.e., group I, (claims 27-38), this invention was properly elected by original presentation.

In response to the objection to the specification and rejections of claims 27-38, with respect to means-plus-function limitations, the Examiner recognizes that the means-plus-function language shall be construed to cover the corresponding structure in the specification and equivalents thereof. However, the Examiner does not agree it is clear from the specification what structure corresponds to the various means-plus-function claim limitations in the claims. In the instant Reply Applicant has made various connections between the means-for-limitations recited in the claims and elements in the disclosure, however, the rules of the PTO require that application claims must "conform to the invention as set forth in the remainder of the specification and the terms and phrases used in the claims must find clear support or antecedent basis in the description so that the meaning of the terms in the claims may be ascertainable by reference to the description." 37 CFR 1.75(d)(1).

In response to the rejection of claims 27-38 under 35 U.S.C. 102(b) as being anticipated by Babson (US Patent no. 5,885,529), Applicant again argues that Babson does not determine an individual path for each sample. Applicant alleges that the computer of Babson merely "allows the operator to pick the tests desired for each sample, and, if desired, to prioritize the sample if stat or unstable", otherwise the reference assay samples "methodically sequence around the carousel...". The Examiner respectfully disagrees with Applicant's analysis of the Babson controller (i.e., computer 12). The entire instrument 10 of Babson is controlled by the computer controller 12. As discussed above-referenced Final action, Babson teaches that the computer controller 12 allows the operator to pick the tests desired for each sample, and, if desired, to prioritize the sample if stat or unstable. The computer 12 can then instruct the instrument 10 to pick the right bead and reagent and put them in a reaction tube with a particular sample for assay (i.e., one type of resource requirement). Based on the particular assay having a particular duration of incubation (another type of resource requirement), the computer determines how the reaction tubes will be processed along the individual paths (213, 213', 213b, etc) before analysis. The Babson resource requirements correspond to the types of resource requirements cited in Applicant's invention, see page 10, lines 21-26 of Applicant's specification. These requirements include types of reagents added, duration of incubation, number wash cycles, etc.

Babson also teaches the controller determines the individual paths for each sample, based on the test desired for each sample. For instance, if the reaction tube needs to be advanced to wash and photometric analysis, the reaction tubes are shuttled out of the tube processor 213 and are picked up by a circular chain and moved to a high speed spin wash station 214 (first path). If additional incubation is desired for a sample, chain 213b is used to circle the reaction tube back to the beginning of the serpentine channel 213' (second path). In addition, the reaction vessels can be returned to reaction pipetting station 204 by side chain 213b where more reagents is added (resource requirement), if necessary for the assay, before the steps of incubation and wash are repeated (third path). See for example col. 7, line 40-col. 8, line 39 and col. 10, lines 17 et seq., of Babson. Contrary to Applicant's assertion, Babson does disclose a controller which determines the individual paths for each sample, based on the particular assay and incubation time required for each sample.

Continuation of 13. Other: Applicant's reply has overcome the objection to the drawings under 37 CFR 1.83(a) on the ground that the "means for delivering" in claim 32 is not illustrated since this language has been removed.